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Remarks

The applicant provides the following remarks in response to the office action bearing a mailing date of March 22, 2006. Claims 23-41 are withdrawn. Claims 1-22 remain pending in the present application. In light of the following remarks, the applicant respectfully requests withdrawal of the pending rejections and advancement of this application to allowance.

A. Rejection Under 35 U.S.C. § 112

Claims 5 and 8 stand rejected under 35 U.S.C. § 112, as being indefinite. The applicant respectfully traverses this rejection.

According to the office action, the phrase "semiconductor fabrication process" fails to point out and distinctly claim the invention. The applicant respectfully points out that a claim limitation may be broad, without being indefinite. See M.P.E.P. § 2173.04 ("Breadth of a claim is not to be equated with indefiniteness.") The phrase "semiconductor fabrication process" is understood by those of ordinary skill in the art to include processes used in the fabrication of semiconductor devices, including, without limitation, chemical vapor deposition, physical vapor deposition, electrochemical deposition, molecular beam epitaxy, atomic layer deposition, etc. Thus, the aforementioned claim limitation is broad. However, the scope of the subject matter embraced by this limitation is clear, because, while the aforementioned processes are understood to fall within the realm of the "semiconductor fabrication process," other processes are immediately understood as falling outside that realm. Arc welding, for example, clearly falls outside the realm of the "semiconductor fabrication process."

Because the phrase "semiconductor fabrication process" clearly defines a boundary that certain processes fall within, and other processes fall outside of, the phrase "semiconductor fabrication process" is definite, and is therefore permissible under 35 U.S.C. § 112. For at least these reasons, the applicant respectfully requests reconsideration and withdrawal of the rejection.

B. Rejection Under 35 U.S.C. § 103

Claims 1-22 stand rejected as being obvious over Isen et al. (U.S. Patent No. 5,763,058.) The applicant respectfully traverses this rejection.

Claim 1 recites that a method of forming a battery enabled flexible circuit, among other limitations, includes "forming a second insulating layer on the first insulating layer and the at least one battery, the first and second insulating layers forming a flexible circuit board."

In contrast, as admitted in the office action, Isen et al. fails to disclose or suggest all limitations of claim 1 because the rejection was under §103 rather than §102. Indeed, Isen et al. fails to disclose or suggest "forming a second insulating layer on the first insulating layer and the at least one battery, the first and second insulating layers forming a flexible circuit board." Rather, Isen et al. discloses that an energy source E₁ is printed on a substrate layer 53. See, e.g., col. 11, ll. 46-47; ll. 62-63; Fig. 8. In other words, Isen et al. fails to disclose that the energy source is placed between two insulating layers. Therefore, claim 1 is patentably distinct from Isen et al.

Further, the applicant respectfully submits that the patent office has not met the burden of making a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings so as to arrive at the claimed invention. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations. See, M.P.E.P. § 2143.

As discussed above, the cited reference Isen et al. fails to disclose or suggest all limitations of claim 1 of the present application. Therefore, the patent office has not met the burden of making a *prima facie* case of obviousness. Accordingly, the applicant respectfully requests withdrawal of the pending rejection.

Claims 2-22 are dependent claims and are also allowable over the art of record for the reasons stated herein. The applicant respectfully requests withdrawal of the pending rejection.

C. Conclusion

In light of the above remarks, the applicant respectfully submits that the pending claims are patentably distinct from the cited references, and request withdrawal of the pending rejection. The applicant does not necessarily concede the characteristics of the cited reference and the pending claims set forth in the office action, and notes that there may be other reasons that then pending claims are patentably distinct in addition to those presented herein and reserves the right to raise any such arguments in the future.

Please call the undersigned attorney at 612.336.4608 if there are any questions or if it would be helpful to discuss any issues during the examination of this application.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "John C. Reich".

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